



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,468	06/23/2003	Alex J. Draughon	60655.1200	7233
66170	7590	01/12/2012	EXAMINER	
Snell & Wilmer L.L.P. (AMEX)				PICH, PONNOREAY
ONE ARIZONA CENTER		ART UNIT		PAPER NUMBER
400 E. VAN BUREN STREET		2435		
PHOENIX, AZ 85004-2202				
			NOTIFICATION DATE	
			01/12/2012	
			DELIVERY MODE	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

HSOBELMAN@SWLAW.COM
DMIER@SWLAW.COM
krigby@SWLAW.COM

Response to Amendments and Arguments

Applicant's amendments filed on 1/6/12 are entered. The objections made in the Final office action mailed on 11/18/11 are withdrawn.

Applicant's arguments were fully considered, but are not persuasive. Applicant points to paragraphs 20-21 and 24 for support of the combination of limitations which were rejected under 35 USC 112, first paragraph as lacking written description in the Final office action.

Paragraph 20 (which applicant previously pointed to for support) refers to an embodiment of applicant's invention where a message has an expiration date. The paragraph states that "[o]nce the expiration date occurs, the message is eliminated from the database such that it is no longer accessible." The paragraph also explains several ways that the elimination of the message can be performed. What is important to note is that every example of message elimination described in paragraph 20 results in the message no longer being in the message database. Thus in this embodiment described in paragraph 20, once a message is eliminated, it is no longer accessible to any user since it is no longer in the database for any user to access, regardless of the number of users originally able to access that message.

Paragraph 21 refers to another embodiment wherein the expiration date can be extended. Note that it would have been reasonable for one skilled in the art to infer from the teachings of paragraphs 20-21 that certain features of both embodiments could be combined. Such a combination would result in an invention which allows for the expiration date to be extended as described in paragraph 21 and the elimination of

message to still occur as described in paragraph 20. Such a combination though would still not result in any message being in the database for any user to access once the expiration date has passed and the message is eliminated from the database.

Paragraph 24 describes yet another embodiment of applicant's invention. The description of this embodiment actually begins in paragraph 22 as evidenced by use of the phrase “[i]n yet another embodiment of the present invention...” in paragraph 22, which shows that what is described in paragraphs 22-24 is a separate embodiment from either paragraphs 20 or 21. The particular embodiment described in paragraphs 22-24 utilizes dynamic message retrieval wherein a single copy of the message is stored in the database for multiple users. Because a single, shared copy of the message is saved in the database for retrieval by multiple users, storage space is saved.

While there is no requirement that what is being claimed is recited verbatim in the specification, the specification as originally filed must still provide adequate description of what is being claimed expressly, implicitly, or inherently. As explained in the Final office action, the combination of limitations rejected by the Office as lacking written description support fails this requirement. One cannot combine the features of the embodiments as described in paragraphs 20-24 to achieve an invention wherein only one copy of the message is saved for access by multiple users (i.e. as in paragraphs 22-24) and once the message is eliminated from the database using one of the methods described in paragraph 20 still have that message be available for other users to access since the message no longer exists in the database.

Even if one delayed elimination of the message for a time period as described in paragraph 21, one still would not achieve the combination of limitations under contention. During the extended time period, the message has not yet been eliminated, thus it is still available for access by a first and/or second user as the message still exists in the database. If the message still exists in the database, it is not counted as eliminated for access by a first intended recipient as required in the claims, thus bringing paragraph 21 up as evidence is irrelevant to the issue at hand.

As explained above, the examiner recognizes that there is no requirement for verbatim disclosure in the specification of certain claimed features. In some cases, it would have been obvious to one skilled in the art to find that certain features from different embodiments of the invention may be combined without having to have it spelled out how the combination may occur. However, it is also submitted that not every features from different embodiments can be combined. In this particular case, based on the disclosures in the specification in paragraphs 20-24, it does not appear possible for applicant to have had an invention at the time filed where a single message is saved for access by multiple users in a database and once that message is eliminated from the database (so that a first user can no longer access it), it is still available for a second user to access. Applicant's disclosure in paragraph 20 describes elimination of the message or making the message no longer accessible to the (first) user as making it so that the message no longer exists in the database. A second user cannot possibly access something that no longer exists.

To make an analogy, think of the message as a shared pie that can be eaten by multiple people. Once that pie is gone (because it got totally eaten or disposed in the trash) so that a first person cannot eat it, one cannot logically say that it is still available to be eaten by someone else as that pie no longer exists for such a purpose.